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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/024,923	02/17/1998	DAN KIKINIS	P3295	8936
24739	7590	12/13/2005	EXAMINER	
CENTRAL COAST PATENT AGENCY PO BOX 187 AROMAS, CA 95004			FERRIS, DERRICK W	
		ART UNIT	PAPER NUMBER	
			2663	

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/024,923	KIKINIS, DAN	
	Examiner	Art Unit	
	Derrick W. Ferris	2663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 October 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 20-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 20-28 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 February 1998 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Response to Arguments

1. This Office action is in response to applicant's paper filed 10/5/2005. **Claims 20-28** are pending. Applicant has canceled claim 19. Applicant has added claims 20-28.
2. The examiner **withdraws** the obviousness rejection to *Iwami et al.* in view of *Chang et al* since applicant canceled the claims rendering the rejection moot. However, the examiner notes the above rejection reads on the newly added claims. As such, please see the same rejection below. Applicant provided no further argument with respect to the new claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. **Claims 20, 21, 25, 26 and 27** are rejected under 35 U.S.C. 102(e) as being anticipated by over U.S. Patent No. 5,604,737 A to *Iwami et al. et al.* ("Iwami").

As to **claim 20**, *Iwami* discloses a bridge unit and a method comprising a trunk line port for receiving and placing COST telephone calls (i.e., fig. 1, between 20 and 3, inherently there's a port in order to connect the PSTN network to the server); a data network port and circuitry for placing LAN calls (i.e., fig. 1 between 20 and 1, inherently there's a port in order to connect the server to the LAN); conversion between LAN and COST telephone calls (i.e., fig 7, 22, fig. 8, col. 11, II. 5-15); a lookup table (i.e., column 17, ll. 3-7) relating COST telephone numbers to IP addresses (i.e., column 15, ll. 41-54, the terminal may have a telephone number so the communication may be established and connection to take place) wherein control routine function, extract specific data to access the lookup table (i.e., fig. 18, col. 15, ll. 41-55, the extension and/or the terminal address has to be extracted in order to be compared) and enabling two people to engage in a live conversation and protocol conversion (i.e., fig. 8, col. 11, ll. 20 – column 12, ll. 15). See processor 17 in figure 6 with respect to a processor for the bridge.

As to **claim 21**, the public network 3 is the PSTN.

As to **claims 25**, see e.g., figure 5 which shows a flow chart of call negotiation from the PSTN to a packet-based network.

As to **claims 26**, see also figure 5 with respect to the voice mail option.

As to **claim 27**, see similar rejection to claim 20.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 22 and 24** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,604,737 A to *Iwami et al. et al.* ("*Iwami*") in view of U.S. Patent No. 6,198,738 B1 to *Chang et al.* ("*Chang*").

As such to **claim 22**, see similar rejection for the parent claim(s).

Iwami is silent or deficient to the further limitation that the LAN network includes the Internet. However, *Iwami* discloses that that the communication terminal could be using TCP/IP or UDP/IP (i.e., column 17, ll. 44-58; voice communication may be adapted to support these protocols).

Chang teaches the further recited limitation above at e.g., figure 1, 20; column 1, ll. 13-25).

The proposed modification of the above-applied reference(s) necessary to arrive at the claimed subject matter would be to modify *Iwami* by clarifying that the network is the Internet.

As such, examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include the above limitation. In particular, the motivation for modifying the reference or to combine the reference teachings would be in order to communicate with the greatest number of possible users. The motivation is also the desire to use the network that is most broadly available and therefore preferred.

As to **claim 24**, in addition to similar reasoning used for claim 22, see e.g., figure 18 of *Iwami* where the IP address corresponds to the telephone number.

7. **Claims 23 and 28** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,604,737 A to *Iwami et al. et al.* ("*Iwami*") in view of U.S. Patent No. 6,198,738 B1 to *Chang et al.* ("*Chang*").

As such to **claim 23**, see similar rejection for the parent claim(s).

Iwami is silent or deficient to the further limitation of a look up table relating telephone numbers to IP addresses. In particular, *Iwami* teaches using extension numbers, see e.g., figure 18.

Chang teaches the further recited limitation above at e.g., column 4, lines 6-25 since the ULS server contains a database of address translations.

The proposed modification of the above-applied reference(s) necessary to arrive at the claimed subject matter would be to modify *Iwami* by clarifying that a translation table can also contain IP addresses.

As such, examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include the above limitation. In particular, the motivation for modifying the reference or to combine the reference teachings would be in order to communicate with the greatest number of possible users. The motivation is also the desire to use the network that is most broadly available and therefore preferred.

As to **claim 28**, see similar rejection to claim 23.

8. **Claims 23 and 28** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,604,737 A to *Iwami et al. et al.* ("*Iwami*") in view of GB 2 315 190 A to *Mitel*.

As such to **claim 23**, see similar rejection for the parent claim(s).

Iwami is silent or deficient to the further limitation of a look up table relating telephone numbers to IP addresses. In particular, *Iwami* teaches using extension numbers, see e.g., figure 18.

Mitel teaches the further recited limitation above at e.g., page 9 first full paragraph since the gateway provides a one-to-one mapping function between the user's telephone number and TCP/IP address.

The proposed modification of the above-applied reference(s) necessary to arrive at the claimed subject matter would be to modify *Iwami* by clarifying that a translation table can also contain IP addresses.

As such, examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include the above limitation. In particular, the motivation for modifying the reference or to combine the reference teachings would be in order to communicate with the greatest number of possible users. The motivation is also the desire to use the network that is most broadly available and therefore preferred.

As to claim 28, see similar rejection to claim 23.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (571) 272-3123. The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on (571)272-3139. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Derrick W. Ferris
Examiner
Art Unit 2663


DWF


RICKY Q. NGO
SUPERVISORY PATENT EXAMINER